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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/717,573	11/21/2003	Jen-Leih Wu	33151-188802	3665
23639 7590 05/11/2007 BINGHAM MCCUTCHEN LLP Three Embarcadero Center San Francisco, CA 94111-4067			EXAMINER MCGILLEM, LAURA L	
			ART UNIT 1636	PAPER NUMBER
			MAIL DATE 05/11/2007	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

**Advisory Action  
Before the Filing of an Appeal Brief**

Application No.

10/717,573

Applicant(s)

WU ET AL.

Examiner

Laura McGillem

Art Unit

1636

**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

THE REPLY FILED 17 April 2007 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.  
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**NOTICE OF APPEAL**

2. ☐ The Notice of Appeal was filed on \_\_\_\_\_. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

**AMENDMENTS**

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because  
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);  
(b) ☐ They raise the issue of new matter (see NOTE below);  
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or  
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).  
5. ☒ Applicant's reply has overcome the following rejection(s): 35 U.S.C. 102(a) and 35 U.S.C. 102(b).  
6. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).  
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.  
The status of the claim(s) is (or will be) as follows:  
Claim(s) allowed: \_\_\_\_\_.  
Claim(s) objected to: \_\_\_\_\_.  
Claim(s) rejected: 1, 5-7 and 10-14.  
Claim(s) withdrawn from consideration: \_\_\_\_\_.

**AFFIDAVIT OR OTHER EVIDENCE**

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).  
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).  
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

**REQUEST FOR RECONSIDERATION/OTHER**

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:  
See Continuation Sheet.  
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). \_\_\_\_\_.  
13. ☐ Other: \_\_\_\_\_.

Continuation of 3. NOTE:

Continuation of 11. does NOT place the application in condition for allowance because: Once a final rejection that is not premature has been entered in an application, applicant or patent owner no longer has any right to unrestricted further prosecution. The amendments do not place the application either in condition for allowance.

It is noted that claims 1, 5-6 and 10-11 have been amended and claims 2-4 and 8-9 are canceled in the amendment filed 4/17/2007. In the previous Office actions, the claims are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The rejection of claims 1, 5-7 and 10-14 under 35 U.S.C. 112, first paragraph (written description) would be maintained. The amendment to claim 1 introduces the limitations of claims 3-4 (now cancelled). Although the claimed expression control sequence from a zebrafish now comprises the binding sites of HFH(1), HFH(2), HNF-1alpha and HNF-3beta (SEQ ID NOs: 4-7 respectively), the claim does not put any limitation on the order or arrangement of the four binding site sequences within the claimed isolated polynucleotide from a zebrafish. The claim does not put any limitation of the size of the isolated polynucleotide that would be a liver specific expression control sequence and therefore the claimed isolated polynucleotide encompasses a very large genus of polynucleotides comprising a liver-specific expression control sequence in which the binding sites can be in any order or at any distance from one another. The specification discloses three liver-specific expression control sequences comprising the nucleic acid sequences of SEQ ID NO:1, SEQ ID NO:2 and SEQ ID NO:3. There is no indication that any other sequences from the zebrafish that would comprise SEQ ID NOs: 4-7 in any order and at any distance from the other would have the function of modulation of expression of a vertebrate L-FABP. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Applicant is invited to review MPEP 714.12.

However, the amendments would overcome the rejection of claims 1, 5-7, 10-12 and 14 under 35 U.S.C. 102(b) as being anticipated by Zhong et al. The amendments would overcome the rejection of claims 1, 12 and 14 under 35 U.S.C. 102(a) as being anticipated by Genbank Accession No. AL929535 (Tracey). The amendments would overcome the rejection of claims 1, 12 and 14 under 35 U.S.C. 102(a) as being anticipated by Genbank Accession No. No. AC139623 (Akhter). The amendments would overcome the rejection of claim 1 under 35 U.S.C. 102(a) as being anticipated by Genbank Accession No. BX240588 (Humphray et al).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Laura McGillem whose telephone number is (571) 272-8783. The examiner can normally be reached on M-F 8:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Woitach can be reached on (571)272-0739. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Laura McGillem, PhD  
Examiner  
5/9/2007

CELINE QIAN, PH.D.  
PRIMARY EXAMINER

